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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,403	10/31/2000	Jesse A. May	1700 F US	8448

26356 7590 08/09/2002

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EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/674,403

Applicant(s)

May et al.

Examiner

Bruck Kifle, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 20, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) 3, 4, 7, 8, 11, 12, 15, 16, 19, 20, 23, 24, 27-33, 35-38, 41, 42, 45, 46, 48 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21, 22, 25, 26, 34, 39, 40, 43, 44, and is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 6) ☐ Other:

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Applicant's amendments and remarks filed 5/20/02 have been received and reviewed.

Claims 1-49 are still pending in this application. There is no instruction to cancel claim 34.

Claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21, 22, 25, 26, 34, 39, 40, 43, 44 and 47 are under consideration.

Claims 3, 4, 7, 8, 11, 12, 15, 16, 19, 20, 23, 24, 27-33, 35-38, 41, 42, 45, 46, 48 and 49 are withdrawn.

***Claim Rejections - 35 USC § 112***

Claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21, 22, 25, 26, 34, 39, 40, 43, 44 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) It is unclear which atoms make-up the monocyclic heteroaromatic group denoted by "Aryl." It is not known which atoms are present, how many of each is present, what size ring is intended, etc. Applicants state that heteroaromatic ring refers to thiophene, furan, pyrrole, pyridine, pyriidine, pyridazine and pyrazine. These should be included within the claims.

iv) The last phrase of each claim should read "or a pharmaceutically acceptable salt or solvate thereof" to be of proper Markush language presenting the possibilities in the alternative. The appropriate amendments have not been made.

vi) Claim 34 improperly depends from claim 1. The claim is still present

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vii) In the definition of R<sup>1</sup>, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 17, 18, 21, 22, 25, 26, 43 and 44 are again objected to under 37 CFR 1.75 as being a substantial duplicate of each other. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). All of these claims are drawn to the same composition. The intended use is irrelevant because it does not carry any patentability weight. Different intended uses are given no material weight in such claims. Note *In re Tuominen* 213 USPQ 89.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 1, 2, 17, 18, 21, 22, 25, 26, 39, 40, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Sianesi et al. (DE 2022694 or J. Med. Chem (1973), 16(10), 1133-7)). The claims read on the compound with RN 31848-26-7P (see CAS abstract and structure). This compound is in the keto form but the claims are written in the enol form (when R<sup>1</sup> is OH) which is always present in equilibrium.

Claims 1, 2, 17, 18, 21, 22, 25, 26, 39, 40, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Dean et al. (US 5,153,192). The claims read on the compound of RN 138891-00-6 (see CAS abstract and structure).

Claims 1, 2, 17, 18, 21, 22, 25, 26, 39, 40, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizuno et al. (WO 95/18117). The claims read on the compounds of RN 170631-54-6; 170631-55-7; 170631-57-9; 170631-68-2; 170631-69-3; 170631-75-1; 170631-76-2 and 170631-77-3 (see CAS abstract and structure).

Claims 1, 2, 17, 18, 21, 22, 25, 26, 39, 40, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by May et al. (WO 95/19981). The claims read on the compound of RN 171273-45-3; 171273-60-2 and 171273-87-3 (see CAS abstract and structure).

Claims 1, 2, 17, 18, 21, 22, 25, 26, 39, 40, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Masaki et al. (WO 95/26959). The claims read on the compound of RN 173365-24-7; 173365-36-1; 173365-38-3; 173365-39-4 (see CAS abstract and structure).

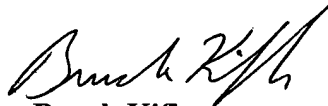
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Claims 1, 2, 17, 18, 21, 22, 25, 26, 39, 40, 43 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Mizuno et al. (US 5,874,429). The claims read on the compound of RN 220716-37-0; 220716-38-1; 170631-68-2; 170631-57-9; 170631-58-0; 170631-76-2; 170631-77-3 (see CAS abstract and structure).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

August 8, 2002

  
**Bruck Kifle**  
**Primary Examiner**  
**Art Unit 1624**